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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,571	07/09/2001	David Michael Shotton	117-352	6937

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EXAMINER

KOSTAK, VICTOR R

ART UNIT PAPER NUMBER

2614

DATE MAILED: 06/24/2004

*[Handwritten mark]*

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/831,571

**Applicant(s)**

SHOTTON ET AL.

**Examiner**

Victor R. Kostak

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-35 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-11 and 13-35 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Or (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 11, 13-18, 21-27 and 230-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Northcutt et al.

The system, source, device, method and medium for storing instructions disclosed by Northcutt (noting particularly Figs. 2, 4, 7 and 8) includes requesting video files from a library at the server station (server 20 in Fig. 2) by a user located at a remote client station 290 through a communications medium (LAN architecture 235). Upon identifying a requested file (by inherent ID data which is data concerning the video (file) data), the user previews an image from the file for tailoring the selected the file as preferred by the user (noting col. 7 line 1+ describing preview mode). The user specifies parameters that involve at least format and spatial extent (i.e. size: e.g. col. 5 lines 50-54) to customize the video data of the selected video file. The parameters are selected by the user and the request for the customized file is accordingly downloaded from the server, thereby meeting claims 1-3 and 33-35.

As for claims 4, 14 and 23, included in the parameter selection besides size (i.e. spatial extent addressed above) is the option of NTSC or PAL video (e.g. col. 9 lines 35-45) which are defined by distinct standardized formats.

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As for claims 5, 15 and 24, the PAL and NTSC formats inherently include the parameter of frame rate, which can be designated a temporal extent.

Regarding claims 6, 16 and 25, the customized video file is transmitted through a LAN network, noted previously.

As for claims 7, 17 and 26, a network server 200 is included, as was also mentioned above.

As for claims 8, 18 and 27, the user station includes a remote computer terminal as shown in Fig. 2.

Considering claims 11, 21 and 30, the parameters involve visual characteristics (e.g. grayscale, color, image size: col. 9 lines 39-46).

As for claims 13, 22 and 32, the video frame rate is one of the characteristics identified and selected (e.g. PAL or NTSC rate), as noted earlier.

Regarding claim 31, plural users can simultaneously access the source (col. 6 lines 18-32).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, 19, 20, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Northcutt et al. in view of Hjalmtysson et al.

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Hjalmtysson also communicates video files involving user-selectable parameters such as formats, allows for any of various media and hardware/software, and points out that control programs can be sent to the user from the server upon request for assigning file characteristics (col. 8 lines 46-65), and mentions programming written Java as being a typical application in user-server instruction requesting/downloading (e.g. col. 1 lines 32-34).

It would have been obvious to one of ordinary skill in the art to use any suitable accessible programming to provide a user with specific instructions pertaining to any specific processing, such as file modification, as is explicitly disclosed by Hjalmtysson, in the similar system of Northcutt, for the benefit of enabling the user to tailor desired files to his liking, as customized multimedia data allows any user to obtain or to create personally suited presentation.

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is informed that newly cited Kenner, Compton and Hunt are all very pertinent to his claims as well as to his disclosure. They all disclose user customization of video files for downloading to a client's station through various media including the Internet. Any initial alteration of a sample image or images can be considered a preview since the video file is customized at the outset for downloading of the remaining complete (or sectioned) file. Hjalmtysson also discloses dynamically creating requested communications services including various formats of video files.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is 703 305-4374. The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

**(703) 872-9306 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 308-HELP.



Victor R. Kostak  
Primary Examiner  
Art Unit 2614

VRK